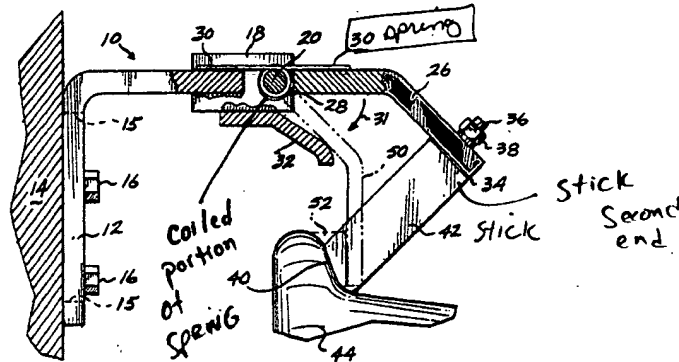


REMARKS/ARGUMENTS

Claim Rejections - 35 USC § 102

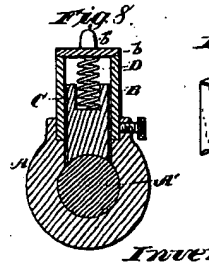
1. The Examiner rejected claims 1-2 under §102(b) as being anticipated by Jamison, U.S. Patent No. 4,811,818.
2. The Examiner rejected claims 1-3 and 7-9 under §102(b) as being anticipated by Brinkerhoff, U.S. Patent No. 282,837.
3. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
4. Claim 1, as amended above, claims:
 1. (Presently Amended) A right rectangular parallelepiped lubricant stick, said stick having a first end extending to second end, said first end for contacting a surface to be lubricated, said second end for contacting a constant force spring of a lubricant applicator, said constant force spring for holding said first end against said surface to be lubricated, said constant force spring comprising a first portion extending to a coiled second portion, said first portion configured to attachment to said lubricant applicator, wherein **said second end defines therein a channel for receiving at least a portion of said coiled second portion.**(emphasis added)
5. Claim 1 clearly states as an element that the second end define a channel for receiving at least a portion of the spring's coiled second portion.

6. However, in the Jamison patent, the following structure is shown:



7. Clearly, the second end of the lubricant stick DOES NOT define therein a channel for receiving at least a portion of said coiled second portion, for the coiled second portion of the spring is nowhere near the stick in Jamison.
8. As such, each and every element as set forth in the claim is not found, either expressly or inherently described in Jamison. Jamison does not anticipate.
9. Claim 2 depends from claim 1. In that claim 1 is not anticipated, claim 2 is likewise not anticipated.
10. As for the Brinkerhoff lubricating mechanism, Brinkerhoff discloses a "conductor" made of a material of "sufficient porosity, either throughout or in a portion of its body, to permit the passage of the lubricant by capillary action or by permeation, whereby the conductor itself may become saturated block to furnish the necessary required lubrication." (Brinkerhoff, col. 2, ll. 64-72).
11. Whereas, the present invention is a "lubricant stick" as is typically used today. Such a modern "lubricant stick" not a porous block of material but instead a consumable piece which is frictionally applied to the surface lubricated, the lubricant stick being consumed in the process.

12. The Brinkerhoff lubricating mechanism shows the use of a compression spring:



13. The present invention utilizes a constant force spring, as mentioned in paragraph [0035]. Constant force spring is clearly the type of spring used in claim 7 et seq.
14. Applicant has amended claim 1 to further define the stick of the present invention is utilized with a constant force spring.
15. Claim 1 requires that the constant force spring comprise "a first portion extending to a coiled second portion, said first portion configured for attachment to said lubricant applicator, wherein said second end defines therein a channel for receiving at least a portion of said coiled second portion."
16. The Brinkerhoff spring does not have a first portion extending to a coiled second portion (a compression spring) but instead is a compression spring (continuous coil from first end to second end).
17. As such, each and every element as set forth in independent claims 1 or 7 are not found, either expressly or inherently described in Brinkerhoff. Claims 2-3 depend from claim 1, claims 8-9 depend from claim 7. In that claims 1 and 7 are not anticipated, claims 2-3 and 8-9 are likewise not anticipated.
18. Further, to constitute an anticipatory reference, the prior art must contain an enabling disclosure. *Chester v. Miller*, 906 F.2d at 1576 n.2, 15 U.S.P.Q.2d at 1336 n.2 (Fed. Cir. 1990); see also *Titanium Metals Corp. of America v. Banner*, 778 F.2d at 781, 227 U.S.P.Q. at 778 (Fed. Cir. 1985).

19. A reference contains an enabling disclosure if a person of ordinary skill could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself, and thereby the public, in possession of the invention. *In re Donohue*, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); *In re Sheppard*, 339 F.2d 238, 242, 144 U.S.P.Q. 42, 45 (C.C.P.A. 1964).

20. Brinkerhoff does not contain an enabling disclosure of the invention of claims 1 and/or 7 because as the lubricant stick of the type referred to in the present invention wears off (lubricant is applied to the surface to be lubricated), a spring must be provided which pushes unworn lubricant stick into contact with the surface constantly so as to continue to apply lubrication to the surface. In Brinkerhoff's case, the "lubricant stick" is merely a porous applicator that doesn't substantially wear but applies a liquid lubricant to the surface through its contact. Thus, utilization of the compression spring in the present invention (in lieu of the constant force spring disclosed) would not be enabling, for the device would not work.

21. For that additional reason, applicant believes that the present invention (claimed in claims 1-12) is not anticipated by either Jamison or by Brinkerhoff.

Claim Rejections - 35 USC § 103

22. The Examiner rejected claims 4-6 and 10-12 under §103(a) as being unpatentable (obvious) in view of Brinkerhoff.

23. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).

24. In this case, the prior art reference (as discussed above) does not teach or suggest all of the claim limitations of the independent claims (1 and 7). For that reason, the present invention is not anticipated.

Conclusion

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 29th day of November 2005.

Very respectfully,



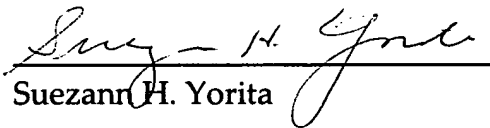
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CERTIFICATE OF MAILING

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service on the below date as first class mail in an envelope addressed to:

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DATE: November 29, 2005


Suezann H. Yorita